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PTO/SB/21 (6-98)
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Patent and Trademark Office: U.S. DEPARTMENT OF COMMERCE

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TRANSMITTAL FORM (to be used for all correspondence after initial filing)	Application Number	09/490,162	
	Filing Date	January 22, 2000	
	First Named Inventor	Ted A. Loxley	
	Group Art Unit		
	Examiner Name		
Total Number of Pages in This Submission	17	Attorney Docket Number	104

ENCLOSURES (check all that apply)		
<input type="checkbox"/> Fee Transmittal Form <input type="checkbox"/> Fee Attached <input type="checkbox"/> Amendment / Response <input type="checkbox"/> After Final <input type="checkbox"/> Affidavits/declaration(s) <input type="checkbox"/> Extension of Time Request <input type="checkbox"/> Express Abandonment Request <input type="checkbox"/> Information Disclosure Statement <input type="checkbox"/> Certified Copy of Priority Document(s) <input type="checkbox"/> Response to Missing Parts/Incomplete Application <input type="checkbox"/> Response to Missing Parts under 37 CFR 1.52 or 1.53	<input type="checkbox"/> Assignment Papers (for an Application) <input type="checkbox"/> Drawing(s) <input type="checkbox"/> Licensing-related Papers <input type="checkbox"/> Petition Routing Slip (PTO/SB/69) and Accompanying Petition <input type="checkbox"/> Petition to Convert to a Provisional Application <input type="checkbox"/> Power of Attorney, Revocation Change of Correspondence Address <input type="checkbox"/> Terminal Disclaimer <input type="checkbox"/> Small Entity Statement <input type="checkbox"/> Request for Refund	<input type="checkbox"/> After Allowance Communication to Group <input type="checkbox"/> Appeal Communication to Board of Appeals and Interferences <input type="checkbox"/> Appeal Communication to Group (Appeal Notice, Brief, Reply Brief) <input checked="" type="checkbox"/> PETITION <input type="checkbox"/> Status Letter <input type="checkbox"/> Additional Enclosure(s) (please identify below):
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SIGNATURE OF APPLICANT, ATTORNEY, OR AGENT	
Firm or Individual name	Vincent A. Greene
Signature	<i>Vincent A. Greene</i>
Date	July 29, 2003

CERTIFICATE OF MAILING	
I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to: Assistant Commissioner for Patents, Washington, D.C. 20231 on this date <u>29 July 2003</u>	
Typed or printed name	Vincent A. Greene
Signature	<i>Vincent A. Greene</i>
Date	July 29, 2003

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OFFICE OF PETITIONS

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant : Ted A. Loxley
Serial No. : 09/490,162
Filed : January 22, 2000
For: PROCESS AND APPARATUS FOR CLEANING SILICON WAFERS
Docket No. : 104

P.O. BOX 1450
Commissioner for Patents
Alexandria, VA 22313-1450
Attention: Technology Center 2800

Petition to Withdraw Holding of Abandonment
Failure to Receive Office Action (No fee)

Sir:

This Petition is filed in response to a Notice of Abandonment received June 16, 2003, based on failure to pay the issue fee. A Notice of Allowance and Issue Fee Due was never received by applicant, and the Patent Office file for this case shows that no such notice was ever prepared or mailed. The present Petition is filed in accordance with MPEP 711.03(c)II and the published PTO notice of October 25, 1993. No fee is required.

There are two important grounds or reasons discussed herein for withdrawing the holding of abandonment. Both involve the fact that counsel for applicant, the attorney of record, did not receive the required notice. The first ground is conclusive, if not irrefutable, and compels grant of this Petition. The PTO records clearly show that a notice of allowance was not typed in 2003 and not sent to applicant.

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The second ground is that counsel for applicant did not receive the notice dated January 28, 2003, which closed the prosecution and stated that a notice of allowance or other appropriate communication would be mailed in due course (The other communication would, of course, indicate why the case was not being passed to issue). The second ground becomes academic and a moot point that need not be considered because the first ground plainly compels grant of this petition.

Counsel for applicant first became aware of the abandonment problem during the week of June 9, 2003, after calling the Patent Office to check the status of the case. He received the Notice of Abandonment on June 16 and then ordered and obtained a complete 240-page file history of the above-identified Loxley application Serial No. 09/490,162 comprising all papers in the PTO's file wrapper (See the appended invoice).

The papers in the PTO file that are material and pertinent to the present Petition are as follows:

(a) A Notice of Allowability (3 pages) and accompanying Notice of Allowance and Fee(s) Due mailed together on October 23, 2002 (received by applicant).

(b) A Notice of Withdrawal from Issue dated December 19, 2002 (also received).

(c) A (so-called) Notice of Allowability (3 pages) having a typed mailing date of January 28, 2003 (not received).

(d) A Notice of Abandonment having a mailing date of June 11, 2003 (The fact is that such notice is clearly improper and also at least one-month premature. The patent issue fee

would not be due before June 11, there could be no abandonment, and such notice could not properly be issued if the Notice of Allowance and Fee(s) Due had been mailed in due course with a delay of only 6 weeks).

Unlike the first Notice of Allowability (a) dated October 23, 2002, the second notice (c) dated January 28, 2003, was not accompanied by a Notice of Allowance and Fee Due. The fact that the PTO file does not contain such a notice of allowance is clear and convincing evidence supporting and requiring a finding that such notice was never prepared or mailed.

Because of the confusing similarity of the terms "notice of allowability" and "notice of allowance", a brief discussion regarding the meaning of those terms and the significance and purpose of the two different notices is in order. An ordinary or inexperienced office worker performing routine clerical work, unlike a patent attorney, cannot be expected to fully understand and appreciate the major differences between the two.

There would be less confusion and less likelihood of error if both notices are mailed together at the same time. However, a "notice of allowability" is misnamed when it is mailed prior to mailing of a notice of allowance. Perhaps a more appropriate term would be "notice of probably allowability" because the notice does not promise or guarantee allowance of the case.

A primary purpose of the so-called "notice of allowability" is to close the prosecution (like a final Office action) so that any new issues raised by an applicant will not be considered. Such a notice commonly includes an Examiner's Amendment and a statement as to why the claimed subject matter has patentable merit.

The first page of a notice of allowability is a printed form (PTOL-37) with a first paragraph that states "If not included herein, a Notice of Allowance (PTOL-85) or other appropriate communication will be mailed in due course."

The dictionary and ordinary meanings of the words "in due course" are (1) at a time that is suitable or proper or (2) in proper order or ordinary sequence. These words as used in the form, PTOL-85, contemplate a delay in the issuance of a notice of allowance that can, of course, vary depending on the particular circumstances of each case.

Applicant has no statistical evidence as to the lengths of such delays, but pertinent evidence is present in the case of Delgar, Inc. v. Schuyler, Comr. Pats., 172 USPQ513 (D.D.C., 1971) set forth in MPEP Section 711.03(c)II as the original basis for the present no-fee petition practice. In the Delgar case (172 USPQ at 518), the delays in issuing notices of allowance were found to fluctuate and were unpredictable, sometimes being less than one month and sometimes being more than four months.

The term "in due course", as employed in the printed notice of allowability (PTOL-37) certainly contemplates a tolerable or unexceptional delay of 8 to 10 weeks, for example,

particularly in the strange and unusual circumstances of the present case.

If the missing notice of allowance in this case had been mailed with a delay of only 6 weeks after the notice of allowability dated January 28, 2003, payment of the issue fee by June 15 would have been timely and there would have been no abandonment.

Counsel for applicant would, of course, be expected to follow standard procedures established by the PTO. An applicant must wait until he receives a Notice of Allowance and Fee(s) Due (PTOL-85) before he is permitted to pay the issue fee. There are many reasons why the Patent Office may choose not to issue a notice of allowance at the time the prosecution is closed by the notice of allowability. An applicant is supposed to wait, even if the notice of allowance is not received promptly.

He has no reason for alarm or serious concern if the allowance is delayed for 2 months, for example. An abandonment resulting from failure to receive the notice of allowance is very rare. Applicants should know that the postal service is usually reliable and would expect to receive any notice of allowance that was mailed and correctly addressed. They have a right to rely on the statement in printed form PTOL-37 that such notice or correspondence other than an allowance will be mailed in due course.

The length of the delay that an attorney might expect will, of course, depend on the circumstances and may be unpredictable, especially in a case involving a rare or highly

unusual situation, such as the withdrawal of a case from issue. A substantial delay of 2 to 3 months, for example, should not be surprising in the present case which is a prime candidate for supervisory review because of the odd and seemingly unexplainable actions of the patent examiner (examples of which are briefly set forth below).

It is manifest that the examiner has serious doubts and misgivings regarding the present patent application is not inclined to allow it. This is not unusual in the case of a young inexperienced examiner lacking expertise in a highly technical art. His tendency may be to discount or reject arguments that should be persuasive because of lack of familiarity with the subject. However, the ordinary examiner would nevertheless follow the usual or standard practice and allow the claims if he has no proper support for a rejection. The actions of the examiner in the present case are not ordinary. His odd behavior suggests that he may have a problem.

Consider, for example, the withdrawal of this case from issue in December, 2002, after the original notice of allowance in October. Such withdrawal is a rare and drastic action that is almost always based on a newly discovered prior art reference. The record shows no reason for such action. No new reference was cited.

The final rejection of October 19, 2001, also involved drastic action that could not be justified. The rules require patent examiners to act on cases in the proper order of priority. After an applicant files his amendment and response to the first

Office action on the merits, the examiner must normally wait 6 to 8 months or more before issuing a second Office action (which may or may not be final). Instead, the examiner made the present case special and issued a hasty off-the-cuff final rejection about one month after applicant's response.

It is customary for the patent examiner to give careful consideration to amendments and arguments submitted after the final rejection in order to simplify or resolve the issues. The examiner refused to do so in this case.

If an examiner really believes that he has adequate and valid grounds for adhering to his final rejection, he should be prepared to defend his position on appeal. In the present case, he failed to answer the appeal brief filed August 17, 2002.

Before the appeal, applicant proposed cancellation of a substantial number of claims including those that the examiner might consider unduly broad in scope. On October 23, 2002, the examiner allowed the case. For some unknown reason, he allowed not only the claims on appeal but also all remaining claims including those that applicant had agreed to cancel.

The issuance of the (second) notice of allowability dated January 28, 2003, would also appear to be strange and hard to explain because the applicant had not submitted any amendment or written arguments after the case was withdrawn from issue.

The point being made is that the actions of the examiner described above are so abnormal as to invite, if not require, supervisory review that could easily result in a delay of more than 2 months within the meaning of "in due course."

Such a long delay could also result from a (secret) quality review under MPEP Section 1308.03 to determine whether any claims may be unpatentable. That section states "The application record should not indicate that a review has been conducted by Quality Review."

In the present case, because of the unusual circumstances and the drastic nature of the actions taken, counsel for applicant had good reason to expect a rather long delay. As pointed out below, it is not unreasonable to suppose and believe that the examiner would be determined and quite zealous in trying to justify a rejection of the patent claims.

One significant fact is that the examiner forced an appeal and then failed to file an Examiner's Answer in response to the Appeal Brief. This suggests an inability to understand the subject or to find plausible or sensible grounds to support the rejection of the appealed claims. Such a disappointing or displeasing performance that is not up to expectations can provide the examiner with a strong incentive to demonstrate his competence and diligence.

Another important fact to be considered is that the Notice of Allowance and Fee Due, dated October 23, 2002, resulted from a successful appeal. When an appeal succeeds as a result of a Board decision or a default when the required Examiner's Answer is not filed, there is a strong presumption that the appealed claims are valid and are directed to an invention having patentable merit. Considering that presumption plus the established policy of the Patent Office to discourage the

rejection of allowed claims, it would appear that the withdrawal of an allowance after an appeal without the citation of newly discovered prior art as in the present case is so extreme and untenable as to discredit or embarrass the examiner. Under such strange and displeasing circumstances, it would be natural for the examiner to become quite zealous and determined to justify his actions, to avoid repercussions, and to protect his reputation. Pride and self-esteem can, of course, provide strong motivation and increase the resolve of the examiner to persevere and find new prior art even when that requires a very thorough and extensive patent search. In the present case, where the field of the invention is highly technical and unfamiliar to the examiner, such a search would indeed be difficult and time consuming. A resulting delay of several months in the present case would be neither surprising nor unexpected.

Perhaps one could fault a busy patent attorney for waiting too long before making a status check. However, the ordinary practitioner would not know what to expect after his allowed application was withdrawn from issue. In my experience, which included four years as a patent examiner, such action was rare indeed. A typical patent lawyer might encounter it only once or twice in his lifetime. It did not happen to this petitioner during the last 30 years, but it is surely more common than that. For the ordinary patent attorney, this could be considered as uncharted territory. As far as petitioner can determine, there are no printed notices or publications and nothing in the MPEP to provide clear guidance in the matter.

Most patent attorneys are conditioned to expect substantial PTO backlogs and long delays during prosecution of a patent application. In the present case there was an expected delay of more than one year between the date of filing in 2000 and the first Office action in 2001. A similar delay is common and not unexpected between the response to the first action on the merits and the next Office action.

In the present case, where the notice of December 19, 2002, set forth no reason for the withdrawal from issue, counsel for applicant had reason to expect the patent examiner to complete his review within a few months and reopen the prosecution with an Office action citing and relying on a new prior art reference and identifying the claims subject to rejection. Counsel would have no reason for concern about a possible abandonment, even when receipt of such Office action was delayed longer than expected because applicant would in any event have up to 6 months to prepare his reply. There never was a mail problem or a reason to question the reliability of the postal service. A long delay would not be a surprise for the reasons set forth previously.

Prior actions of the examiner have clearly demonstrated that he was unpersuaded and disinclined to allow the present case. In prior correspondence, counsel informed the examiner of his intention to reduce the number of patent claims. Although counsel has never discussed the merits of the invention in an interview, he does recall at least one very short telephone conversation, probably relating to a revision or cancellation of

claims. After the last conversation, counsel for applicant was left with the distinct impression that the examiner still had serious doubts about patentability. The delay and failure to receive a notice of allowance was not surprising.

In conclusion, it is submitted that the first ground for withdrawing the holding of abandonment (i.e., the failure of the PTO to prepare or mail a notice of allowance) compels the grant of this Petition.

The second ground is that the notice of allowability dated January 28, 2003, was never received. Counsel for applicant is absolutely certain that such notice and a notice of allowance was never received. The file jacket of this application Serial No. 09/490,162 indicates that those notices were not received (See Appendix Page One).

This petitioner, counsel for applicant, is a sole practitioner with no secretary or clerical help. He has a relatively small number of active cases including a number of provisional patent applications and about 10 pending nonprovisional applications. Unlike a typical patent firm, the number of cases being prosecuted is too small to require the usual docket records. The procedures followed by petitioner are strict, reliable and more than an adequate substitute for docket records. They clearly assure that he is aware of all deadlines and able to meet them.

Every pending patent application being prosecuted by petitioner is kept in a file wrapper with an outer cover with appropriate spaces for identifying actions and amendments and the

date on which each is received. A copy of the outer cover of the subject application is attached to this Petition as Appendix Page One.

Each and every piece of mail received by petitioner from the PTO is opened and inspected promptly. No one else has access to the mail. Whenever he receives an action from the PTO in a pending application he marks the cover of the file wrapper for that application to identify it and indicates the date, usually with a stamp as in the aforesaid Page One. The cover would almost always be stamped on the same day an Office action was received. The file wrapper would then be placed in one drawer of the file cabinet with the other patent applications awaiting action by petitioner. The remaining patent applications awaiting action from the patent examiner are also kept together in a different drawer of the file cabinet.

This system enables petitioner to look at the cases in one drawer and determine from the cover of the file wrapper when an amendment or other response is due in every pending case. Petitioner also keeps informed of all deadlines by regular notes on his calendars. He is particularly diligent with respect to the patent applications of his most important client, Ted A. Loxley, the inventor in the present case.

Petitioner processes every piece of mail he receives and could not possibly misplace or overlook any mail relating to the present patent application because of its great importance. His docketing system is different from that employed by a large patent firm but is probably more reliable.

For the reasons set forth herein, the holding of abandonment in this application was not warranted and should be withdrawn. It is requested that the Petition be granted.

Respectully submitted,

Vincent A. Greene

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25931 Euclid Avenue
Cleveland, Ohio 44132
Telephone (216) 481-7772

Name

Ted A. Loxley

APPENDIX Page One

Address

Title *Process and Apparatus for Cleaning Silicon Wafers*

Assignee

Phone

Allowed

23 OCT 2002

Fee due 1/23/03

Issue Fee Paid

Patent No.

Date

Assignment Recorded: Date

Reel

Frame

Attorney

V. A. Greene

ACTIONS AND AMENDMENTS

Loxley (740) 384-6240

09490162

Nature	Date	Nature	Date
RECEIPT	20 MAR 2000	AMENDMENT	29 JUN 2002
OFFICE ACTION	30 MAR 2001	Extension	8/17/02
Amendment	27 APR 2001	APPEAL BRIEF	17 AUG 2002
REJECTION	23 MAY 2001	Allowance	23 OCT 2002
AMENDMENT	19 SEP 2001	Withdrawal	19 Dec 2002
FINAL REJECTION	19 OCT 2001	Notice of Abandonment	11 June 2003
Amendment	5 DEC 2001	Petition	
APPEAL	17 JAN 2002		
Amend PTO-1449	31 JAN 2002		
Advisory ACTION	2/16/02		
ADV ACTION	15 FEB 2002		
Extension	29 JUN 2002		

Remarks

104

Notice of Allowability

Application No.

09/490,162

Examiner

Viktor Simkovic

Applicant(s)

LOXLEY, TED A.

Art Unit

2812

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address--

All claims being allowable, PROSECUTION ON THE MERITS IS (OR REMAINS) CLOSED in this application. If not included herewith (or previously mailed), a Notice of Allowance (PTOL-85) or other appropriate communication will be mailed in due course. **THIS NOTICE OF ALLOWABILITY IS NOT A GRANT OF PATENT RIGHTS.** This application is subject to withdrawal from issue at the initiative of the Office or upon petition by the applicant. See 37 CFR 1.313 and MPEP 1308.

1. ☒ This communication is responsive to 1/23/03.
2. ☒ The allowed claim(s) is/are 7-10, 12, 18, 19, 21, 28, 29, 31 and 34.
3. ☒ The drawings filed on 22 January 2000 are accepted by the Examiner.
4. ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 - a) ☐ All b) ☐ Some* c) ☐ None of the:
 1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a)).
- * Certified copies not received: _____.
5. ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
 - (a) ☐ The translation of the foreign language provisional application has been received.
6. ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Applicant has THREE MONTHS FROM THE "MAILING DATE" of this communication to file a reply complying with the requirements noted below. Failure to timely comply will result in ABANDONMENT of this application. **THIS THREE-MONTH PERIOD IS NOT EXTENDABLE.**

7. ☐ A SUBSTITUTE OATH OR DECLARATION must be submitted. Note the attached EXAMINER'S AMENDMENT or NOTICE OF INFORMAL PATENT APPLICATION (PTO-152) which gives reason(s) why the oath or declaration is deficient.
8. ☐ CORRECTED DRAWINGS must be submitted.
 - (a) ☐ including changes required by the Notice of Draftsperson's Patent Drawing Review (PTO-948) attached
 - 1) ☐ hereto or 2) ☐ to Paper No. _____.
 - (b) ☐ including changes required by the proposed drawing correction filed _____, which has been approved by the Examiner.
 - (c) ☐ including changes required by the attached Examiner's Amendment / Comment or in the Office action of Paper No. _____.

Identifying indicia such as the application number (see 37 CFR 1.84(c)) should be written on the drawings in the top margin (not the back) of each sheet. The drawings should be filed as a separate paper with a transmittal letter addressed to the Official Draftsperson.

9. ☐ DEPOSIT OF and/or INFORMATION about the deposit of BIOLOGICAL MATERIAL must be submitted. Note the attached Examiner's comment regarding REQUIREMENT FOR THE DEPOSIT OF BIOLOGICAL MATERIAL.

Attachment(s)

- | | |
|---|--|
| 1 <input type="checkbox"/> Notice of References Cited (PTO-892) | 2 <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3 <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 4 <input type="checkbox"/> Interview Summary (PTO-413), Paper No. _____ |
| 5 <input checked="" type="checkbox"/> Information Disclosure Statements (PTO-1449), Paper No. <u>11</u> | 6 <input type="checkbox"/> Examiner's Amendment/Comment |
| 7 <input type="checkbox"/> Examiner's Comment Regarding Requirement for Deposit of Biological Material | 8 <input type="checkbox"/> Examiner's Statement of Reasons for Allowance |
| | 9 <input type="checkbox"/> Other |

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AUG 01 2003

Landon Stark Cantwell & Paxton

2011 Crystal Drive - Suite 210
Arlington, VA 22202-3709
USA

Invoice

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63676

Order Number:
28582

To: **VINCENT GREENE**
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CLEVELAND, OH 44132
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Invoice Date:
7/9/03

Due Date:
8/8/03

Your
Ref: **NONE GIVEN**

VG VG

COPY

Description	Amount
09/490,162	
Services rendered in connection with obtaining and forwarding a copy of the file history for the above identified US Patent(s).	59.25
--ITEMS BELOW THIS LINE WERE DISBURSED ON YOUR BEHALF--	
Copies	59.25
FedEx	23.75
Total Invoice Amount: \$ 142.25	

We are pleased to announce the merger of Landon & Stark and Cantwell & Paxton